



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,512	04/16/2001	Joao Antonio Crespo Fontes	205815US2PCT	9344

22850 7590 10/29/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SWERDLOW, DANIEL

ART UNIT PAPER NUMBER

2644

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,512

Applicant(s)

FONTES, JOAO ANTONIO
CRESPO

Examiner

Daniel Swerdlow

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 is/are rejected.
7) ☒ Claim(s) 1-9 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/16/01.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

U.S. National Stage Application

1. Acknowledgment is made of the indication that the present application is filed under 35 U.S.C. 371, of the indication that the required Form PCT/DO/EO/903 is present and of the use of transmittal form PCT/DO/EO/1390. Thus, the present application is being treated as a filing under 35 U.S.C. 371.

Drawings

2. The drawings are objected to because they contain numerous misspellings and typographical errors. For example:
- In Figure 2, the descriptive legend for step 12 is incomplete.
 - In Figure 14, the word “finishes” is misspelled in step 72 and the word “user” is misspelled in step 67.
 - In Figure 15, the word “warns” is misspelled in step 70.
3. In addition, Figure 1 requires descriptive legends to make the drawing understandable. See 37 CFR § 1.84(o).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

Art Unit: 2644

be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 1 through 9 are objected to because of the following informalities:
5. The claims recite multiple elements without intervening line indentations. See 37 CFR § 1.75(i). Appropriate correction is required.
6. Claims 2 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
7. Claim 2 appears to alternatively claim various subsets of the limitations of Claim 1, from which it depends. As such it removes limitations from the claim from which it depends and therefore attempts to broaden that claim rather than further limit it.
8. Claim 9 claims the system of Claim 1 "characterized by not having all the functions described". As such it removes limitations from the claim from which it depends and therefore attempts to broaden that claim rather than further limit it.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1 through 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. Claim 1 claims both apparatus (i.e., machine) elements (e.g., memories, digital counter, clock, relay) and method (i.e., process) steps (e.g., comparing [the number] with the prefixes in the memories, counting the number of digits, checking with the time counter). Because the statute refers to the classes of invention in the alternative, the claim is directed to non-statutory subject matter.

12. Claims 2 through 9 are non-statutory at least due to dependence from Claim 1.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1 through 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Art Unit: 2644

16. The claims use definite articles extensively, creating numerous ambiguities as to antecedent basis. For example, Claim 1 recites the limitation "the change of timetable" in the 18th line without antecedent basis.

17. Claim 1 apparently comprises two alternatives, one preceded by the recitation "characterized in the first case by" in the 4th line and the other preceded by the recitation "the second alternative consisting of" spanning the 20th and 21st lines. It is unclear whether the claim broadly refers to a system that comprehends either one of these alternatives or more narrowly comprehends a single system that incorporates both alternatives. For the purpose of this Office action to advance prosecution to the maximum extent possible, examiner makes prior art rejections below for both "alternatives" listed in the claim.

18. Claims 1, 2, 3 and 7 incorporate references to drawings in the disclosure. As such, the claims themselves do not distinctly claim the subject matter. Further, the references to the drawings render the claims indefinite because it is not clear whether they refer to each element in the drawings or any element in the drawings.

19. Regarding Claim 3, the phrase "using a logic of analysis like" (3rd line) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

20. Regarding Claim 8, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

21. Claims 2 through 9 are indefinite at least due to dependence from Claim 1.

Art Unit: 2644

22. Examiner has made a good faith effort to interpret the claims in order to make the prior art rejections below for the purpose of advancing prosecution to the maximum degree possible in spite of the difficulties indicated by the rejections and objections above. It should be noted that when claim limitations are recited in the alternative, it is only necessary to show anticipation or obviousness any one of the alternative recitations. Applicant makes consistent use of alternative construction, with the word "or" appearing fourteen times in Claim 1 alone. To the extent practical, examiner has attempted to show how the cited prior art meets as many of the alternative limitations as possible.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 1 through 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mijares, Jr. et al. (US Patent 6,330,331) in view of Soshea et al. (US Patent 5,563,938) and further in view of McIntosh (US Patent 6,169,799).

25. Regarding the first "alternative" in Claim 1, Mijares discloses a low cost telephone routing system (Figs. 2, 3) that includes memories (Fig. 2, reference 54, 56), a timer (Fig. 4b, step 114), selection of carrier based on current time (Fig. 10, step 210; column 14, lines 16-18) that inherently includes a clock, and a bypass switch (i.e., relay) (Fig. 2, reference 58; column 7, lines 25-31) and is implemented as an external device to complement the use of a telephone (Fig.

Art Unit: 2644

3, reference 12) or integrated into a telephone (Fig. 19). Mijares further discloses making a choice of carrier (i.e., telephone company) (Fig. 4a, step 94; column 9, lines 48-60) based on prior user settings (Fig. 7, step 164; column 12, lines 30-36) via DTMF commands (i.e., buttons). Mijares further discloses automatic selection based on time of day (i.e., automatically changed by the clock) (Fig. 4a, step 92, 94; column 9, lines 1-2). Mijares further discloses audible announcement of changes in the current database of carrier selections (i.e., audible warning signaling change of timetable) (Fig. 7, step 164-168; column 12, lines 37-54). Mijares further discloses determining completion of input of a telephone number using a timer (i.e., checking a time counter) (Fig. 4a, step 88; column 8, lines 50-55). As such, Mijares anticipates all elements of the "alternative" except: comparing the number with prefixes in the memories by counting digits and adding an area prefix and/or activating the relay to send the call on another line. Soshea discloses a diverter switch that directs local calls to one line and toll calls to another line activating the relay to send the call on another line) (i.e., (Fig. 1a, reference 29; column 4, line 33-53). Soshea teaches the desirability of such an arrangement to provide convenience for a telephone user in an alternate carrier environment (column 1, line 53 through column 2, line 3). It would have been obvious to one skilled in the art at the time of the invention to apply the diverter switch taught by Soshea to the routing system taught by Mijares for the purpose of realizing the aforesaid advantages. McIntosh discloses an area code determining system that counts digits (Fig. 3, step 306) and compares dialed numbers with memory numbers, including prefixes (Fig. 5, step 502). McIntosh further discloses that automatic determination of area codes greatly reduces a caller's tendency to misdial (column 1, lines 48-55). It would have been obvious to one skilled in the art at the time of the invention to apply the area code prepending

Art Unit: 2644

system taught by McIntosh to the combination made obvious by Mijares and Soshea for the purpose of realizing the aforesaid advantages.

26. Regarding the additional limitations of the second "alternative", Mijares further discloses making a choice of carrier (i.e., telephone company) (Fig. 4a, step 94; column 9, lines 48-60) based on current user selections (i.e., user selects company or line) (Fig. 11, step 222; column 15, lines 44-64) via selection input (i.e., buttons) wherein the selection is maintained for a preset period (i.e., fixed from call to call) (Fig. 11, step 228; column 15, line 65 through column 16, line 1), but automatically changed back at the end of the period (i.e., changed by the clock) (fig. 11, step 232). Mijares further discloses changing carriers with user confirmation (Fig. 7, step 164-168; column 12, lines 30-48). While the cited references do not specifically disclose changing carriers based on better prices, the choosing a service provider based on price is well-known and one would be motivated to do so in order to realize a clear economic advantage.

27. Regarding Claim 2, as stated above under *Claim Objections*, Claim 2 is not further limiting on Claim 1. As such, it is obvious for reasons stated above apropos of Claim 1.

28. Regarding Claim 3, as stated above apropos of Claim 1, Mijares discloses determining completion of input of a telephone number using a timer (i.e., counting of time) (Fig. 4a, step 88; column 8, lines 50-55) and McIntosh discloses an area code determining system that counts digits (Fig. 3, step 306) and compares dialed numbers with memory numbers, including prefixes (Fig. 5, step 502).

29. Regarding Claim 4, as stated above apropos of Claim 1, Mijares discloses making a choice of carrier (i.e., telephone company) (Fig. 4a, step 94; column 9, lines 48-60) based on current user selections (i.e., user selects company or line) (Fig. 11, step 222; column 15, lines 44-

Art Unit: 2644

64) via selection input (i.e., buttons) wherein the selection is maintained for a preset period (i.e., fixed from call to call) (Fig. 11, step 228; column 15, line 65 through column 16, line 1), but automatically changed back at the end of the period (i.e., changed by the clock) (fig. 11, step 232).

30. Regarding Claim 5, the mere alteration of details as to the type of prefixes, etc. to suit a particular country or user is within the capability of one skilled in the art and is clearly motivated for the purpose of making the system work in that country or for that user.

31. Regarding Claim 6, McIntosh further discloses resolution of ambiguous situations with a special symbol key (column 3, lines 57-65).

32. Regarding Claim 7, Mijares further discloses automatic updating of the user carrier database (Fig. 6, column 11, lines 47-65), which inherently includes a standard message.

33. Regarding Claim 8, Mijares further discloses automatic updating of the user carrier database (column 2, lines 44-54) to ensure the lowest rate carrier is used.

34. Regarding Claim 9, as stated above under *Claim Objections*, Claim 9 is not further limiting on Claim 1. As such, it is obvious for reasons stated above apropos of Claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Swerdlow whose telephone number is 703-305-4088. The examiner can normally be reached on Monday through Friday between 8:00 AM and 4:30 PM.

Art Unit: 2644

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forrester Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Daniel Swerdlow', is written over a horizontal line.

Daniel Swerdlow, Patent Examiner Art Unit 2644